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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,923	10/10/2001	Kelan C. Silvester	ITL.0667US (P12985)	1093
21906 7590 02/22/2011 TROP, PRUNER & HU, P.C. 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			EXAMINER COLIN, CARL G	
			ART UNIT 2493	PAPER NUMBER
			MAIL DATE 02/22/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/974,923	<b>Applicant(s)</b> SILVESTER, KELAN C.	
	<b>Examiner</b> CARL COLIN	<b>Art Unit</b> 2493	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-29 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4,5,7-12,14-21 and 23-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,13, and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Response to Arguments**

1. Claims 1-5 and 7-29 are pending. In communications filed on 12/29/2010, applicant has amended claims 1, 11, and 20 and cancels only claims 2, 3, 12, 13, 21, and 22. Applicant's amendments are not proper and will not be entered because claims 1, 11, and 20 are among the claims affirmed by the Board of Patent Appeals and Interferences and all affirmed claims should be cancelled according to MPEP § 1214.06.

2. The amendment filed on 12/29/2010 after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed amendment was not suggested in an explicit statement by the Board under 37 CFR 41.50(c). As provided in 37 CFR 1.198, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner after a final decision of the Board except under the provisions of 37 CFR 1.114 (request for continued examination) or 37 CFR 41.50 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

3. The Board of Patent Appeals and Interferences affirmed the rejection(s) against independent claim(s) 1, 11, and 20, and dependent claims 2, 4, 5, 7-10, 12, 14-19, 21, and 23-29 but reversed all rejections against claim(s) 3, 13, and 22 dependent thereon. There are no

allowed claims in the application. The affirmed claim(s) is/are cancelled by the examiner and the dependent claims that are reversed are converted into independent form by examiner's amendment, in accordance with MPEP § 1214.06.

#### **EXAMINER'S AMENDMENT**

4. An examiner's amendment to the record appears below. The application has been amended as follows:

Claims 1, 2, 4, 5, 7-12, 14-21, and 23-29 are cancelled.

Claim 3 (Currently amended) A method comprising:

disabling an operation of a wireless device that fails to communicate with a base station over a range limited wireless protocol; and

sending a short-range wireless signal from said wireless device to said base station,

~~The method of claim 2~~ wherein sending a short-range wireless signal includes sending a Bluetooth protocol signal.

Claim 13 (Currently amended) A portable wireless device comprising:

a processor;

a wireless receiver;

and a storage coupled to said processor, said storage storing instructions that enable the processor to disable an operation of a wireless device that fails to

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communicate with a base station over a range limited wireless protocol;

wherein said receiver receives a short-range wireless signal; and

disabling an operation of a wireless device that fails to communicate with  
a base station over a range limited wireless protocol; and

~~The device of claim 2~~ wherein said receiver is a Bluetooth protocol  
transceiver.

Claim 22 (Currently amended) An article comprising a medium storing  
instructions that enable a processor-based system to:

send a wireless signal from a portable device to a base station;

disable an operation of the device that fails to communicate with a base  
station over a range limited wireless protocol;

receive a short-range wireless signal; and

~~The article of claim 21 further storing instructions that enable the  
processor-based system to~~ receive a Bluetooth protocol signal.

5. In view of the Board of Appeals and Interferences decision filed on 10/29/2010,  
PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following  
two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

The Technology Center Director has approved of reopening prosecution by signing below:

/Timothy P Callahan/

Director, Technology Center 2400.

### **Specification**

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 23 recites an article comprising a medium. The term medium is not defined in the specification as to determine its scope.

### **Claim Rejections - 35 USC § 101**

7. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a storage medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is absent an explicit definition or is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2. The Examiner suggests amending the claim to include non-transitory computer-readable storage medium.

Any amendment to the claim should be commensurate with its corresponding disclosure.

### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 3, 13, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,166,688 to **Cromer et al** in view of US Patent 6,912,373 to **Lee**.

As per claim 3, **Cromer et al** substantially teaches a method comprising disabling an operation of a wireless device included within a portable computer (wireless device is capable of transmitting wireless RF signal that meets the recitation of short-range wireless signal), in response to the portable computer being moved outside of an authorized area of use, geographical area being any geographical area capable of being defined (column 8, lines 23-28);



the portable computer may be located within a room or building controlled by a gate (that meets the recitation of base station), which includes a wireless transmitter/receiver for transmitting information to/from the portable computer to the gate (see column 3, lines 21-26 and column 3, line 61 through column 4, line 16; and column 4, lines 34-42 and column 5, lines 57-65) that meets the recitation of disabling an operation of a wireless device that fails to communicate with a base station over a range limited wireless protocol, including sending a short range wireless signal from said wireless device to base station. Examiner's broad but reasonable interpretation of the claim is the following; "disabling a device that fails to communicate the proper authentication and the device becomes inoperable when disabled". Applicant's specification describes the claimed limitation as "the base station may only allow user to access stored data after being properly authenticated" (page 4, lines 2-9). In another embodiment the specification describes, "upon receiving the handshake signal, the base station may request an identifier, if the identifier is authenticated by the base station, communication or operation with the system may be allowed, enabling the device to be utilized" (page 5, lines 3-16). Cromer discloses in response to failure of communicating the correct password that matches an authorized area, a device is disabled and becomes inoperable, which is a reasonable interpretation of the recited failure to communicate the proper authentication. "During Patent Examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d, 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)." (See MPEP § 2111).

**Cromer et al** does not explicitly teach wherein sending a short range wireless signal includes sending a Bluetooth protocol signal, which is also well known in the art. However, **Lee**

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in an analogous art discloses how a Bluetooth device communicates with a Bluetooth access point (base station) to determine active channels (see column 8, lines 9-17). **Lee** further teaches the advantages of using Bluetooth technology for wireless communication of data from/to the Bluetooth device to/from a wireless access point (base station). Some of the advantages of using Bluetooth technology are that it provides low cost, low electricity power radio communication, and aims for replacing cables, and realized into a chip-type solution since it can be installed in various kinds of portable devices (see column 1, lines 19-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the wireless device of **Cromer et al** to provide a Bluetooth protocol wireless device for sending/receiving Bluetooth protocol signal as taught by **Lee**. One of ordinary in the art would have been lead to make such a modification since Bluetooth technology provides several advantages such as low cost, low electricity power radio communication, and aims for replacing cables, and realized into a chip-type solution since it can be installed in various kinds of portable devices as suggested by **Lee**.

As per claim 13, **Cromer et al** substantially teaches a wireless system comprising a gate coupled to a server capable of transmitting and receiving wireless signals that meets the recitation of processor; a wireless transceiver; and a storage coupled to said processor (see claims 29 and 30), said storage storing instructions that enable the processor to authenticate a received wireless signal, and, if the signal is not authenticated, disable an operation of the device (see claims 29 and 30) that meets the recitation of disable an operation of a wireless device that fails to communicate with a base station over a range limited wireless protocol, wherein said

receiver receives a short range wireless signal from said wireless device to base station.

Examiner's broad but reasonable interpretation of the claim is the following; "disabling a device that fails to communicate the proper authentication and the device becomes inoperable when disabled". Applicant's specification describes the claimed limitation as "the base station may only allow user to access stored data after being properly authenticated" (page 4, lines 2-9). In another embodiment the specification describes, "upon receiving the handshake signal, the base station may request an identifier, if the identifier is authenticated by the base station, communication or operation with the system may be allowed, enabling the device to be utilized" (page 5, lines 3-16). Cromer discloses in response to failure of communicating the correct password that matches an authorized area, a device is disabled and becomes inoperable, which is a reasonable interpretation of the recited failure to communicate the proper authentication. "During Patent Examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d, 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)." (See MPEP § 2111).

**Cromer et al** does not explicitly teach wherein said receiver is a Bluetooth protocol tranceiver, which is also well known in the art. However, **Lee** in an analogous art discloses how a Bluetooth device communicates with a Bluetooth access point (base station) to determine active channels (see column 8, lines 9-17). **Lee** further teaches the advantages of using Bluetooth technology for wireless communication of data from/to the Bluetooth device to/from a wireless access point (base station). Some of the advantages of using Bluetooth technology are that it provides low cost, low electricity power radio communication, and aims for replacing

cables, and realized into a chip-type solution since it can be installed in various kinds of portable devices (see column 1, lines 19-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the wireless device of **Cromer et al** to provide a Bluetooth protocol transceiver for sending/receiving Bluetooth protocol signal as taught by **Lee**. One of ordinary in the art would have been lead to make such a modification since Bluetooth technology provides several advantages such as low cost, low electricity power radio communication, and aims for replacing cables, and realized into a chip-type solution since it can be installed in various kinds of portable devices as suggested by **Lee**.

As per claim 22, **Cromer et al** substantially teaches an article comprising a medium storing instructions that enable a processor-based system to disabling an operation of a wireless device included within a portable computer (wireless device is capable of transmitting wireless RF signal that meets the recitation of short-range wireless signal), in response to the portable computer being moved outside of an authorized area of use, geographical area being any geographical area capable of being defined (column 8, lines 23-28); the portable computer may be located within a room or building controlled by a gate (that meets the recitation of base station), which includes a wireless transmitter/receiver for transmitting information to/from the portable computer to the gate (see column 3, lines 21-26 and column 3, line 61 through column 4, line 16; and column 4, lines 34-42 and column 5, lines 57-65) that meets the recitation of send/receive a short range wireless signal from said wireless device to base station disabling an operation of a wireless device that fails to communicate with a base station over a range limited

wireless protocol. Examiner's broad but reasonable interpretation of the claim is the following; "disabling a device that fails to communicate the proper authentication and the device becomes inoperable when disabled". Applicant's specification describes the claimed limitation as "the base station may only allow user to access stored data after being properly authenticated" (page 4, lines 2-9). In another embodiment the specification describes, "upon receiving the handshake signal, the base station may request an identifier, if the identifier is authenticated by the base station, communication or operation with the system may be allowed, enabling the device to be utilized" (page 5, lines 3-16). Cromer discloses in response to failure of communicating the correct password that matches an authorized area, a device is disabled and becomes inoperable, which is a reasonable interpretation of the recited failure to communicate the proper authentication. "During Patent Examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d, 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)." (See MPEP § 2111).

**Cromer et al** does not explicitly teach instructions that enable the processor-based system to receive a Bluetooth protocol signal, which is also well known in the art. However, **Lee** in an analogous art discloses how a Bluetooth device communicates with a Bluetooth access point (base station) to determine active channels (see column 8, lines 9-17). **Lee** further teaches the advantages of using Bluetooth technology for wireless communication of data from/to the Bluetooth device to/from a wireless access point (base station). Some of the advantages of using Bluetooth technology are that it provides low cost, low electricity power radio communication, and aims for replacing cables, and realized into a chip-type solution since it can be installed in various kinds of portable devices (see column 1, lines 19-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the wireless device of **Cromer et al** to provide a Bluetooth protocol wireless device for sending/receiving Bluetooth protocol signal as taught by **Lee**. One of ordinary in the art would have been lead to make such a modification since Bluetooth technology provides several advantages such as low cost, low electricity power radio communication, and aims for replacing cables, and realized into a chip-type solution since it can be installed in various kinds of portable devices as suggested by **Lee**.

### Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses Bluetooth protocol signal between a wireless device and a base station.

US Patents: 6,968,219 Pattabiraman;  
7,088,691 Fujita;  
7,075,908 Noguchi et al

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL COLIN whose telephone number is (571)272-3862. The examiner can normally be reached on 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Colin/

Primary Examiner, Art Unit 2493

February 12, 2011

/JOSEPH THOMAS/

Supervisory Patent Examiner, Art Unit 2492